



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

1N21/0908

DONALD C LUCAS
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NEW YORK NY 10016

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
08/851,485	05/05/97	010	THEKORN, E	1/23 09/08/98
First Named Applicant	ARMSTRONG, DANIEL W.			

TITLE OF INVENTION MACROCYCLIC ANTIBIOTICS AS SEPARATION AGENTS

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
0	AST-4A-PCT-U	210-635.000	1/3 UTILITY	YES	\$660.00	12/08/98

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- A. Pay FEE DUE shown above, or
- B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give application number and batch number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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Patent and Trademark Office**

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Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
US/851,485	US/05/97	ARMSTRONG	D 851-4A-PCT-U

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NEW YORK NY 10016

1921/0908

EXAMINER

THERGORN, E

ART UNIT	PAPER NUMBER
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1723

10

DATE MAILED:

09/08/98

#9

C

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

NOTICE OF ALLOWABILITY

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

- ☒ This communication is responsive to Aug 5, 1998
- ☒ The allowed claim(s) is/are 1, 5, 6, 9, and 15-20
- ☐ The drawings filed on _____ are acceptable.
- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☒ received in Application No. (Series Code/Serial Number) 08/532,581
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

 A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.
- ☒ Applicant MUST submit NEW FORMAL DRAWINGS
- ☐ because the originally filed drawings were declared by applicant to be informal.
- ☒ including changes required by the Notice of Draftperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. 4 of 4
- ☐ including changes required by the proposed drawing correction filed on _____, which has been approved by the examiner.
- ☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftperson.

- ☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 and 5
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Interview Summary, PTO-413
- ☒ Examiner's Amendment/Comment
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☒ Examiner's Statement of Reasons for Allowance

BEST AVAILABLE COPY

08/851,485



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Patent and Trademark Office
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Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKETT NO.
08/851,485	05/05/97	ARMSTRONG	D 851-4A-PCT-U

DONALD C. LUCAS
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IM21/0908

EXAMINER
THERKORN, E.

ART UNIT
1/23

PAPER NUMBER

DATE MAILED: 09/08/98 #8

EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant, applicant's representative, PTO personnel):

(1) Donald C. Lucas (3) _____
(2) E. Therkorn (4) _____

Date of interview Sept 3, 1998Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).Exhibit shown or demonstration conducted: ☐ Yes ☒ No. If yes, brief description: _____Agreement ☒ was reached with respect to some or all of the claims in question. ☐ was not reached.Claims discussed: The claims of recordIdentification of prior art discussed: None

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: The examiner proposed the amendment listed in the examiner's amendment to limit the claims to the elected species of chromatography and the obviously intended elected species of "macrolides, non-glycopeptide macrocyclic peptides and polyenes." Donald C Lucas then authorized the changes by examiner's amendment

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

☒ 1. It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph below has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., items 1-7 on the reverse side of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

☐ 2. Since the examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the substance of the interview unless box 1 above is also checked.

Donald C. Lucas
Examiner's Signature

Art Unit: 1723

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

In claim 1, line 5, "electrophoresis or" has been deleted. In line 8, after "macrolides, ", - - non-glycopeptide - - has been inserted.

In claim 5, line 2, "membrane separation, electrophoresis or" has been deleted.

In claim 6, line 2, "electrophoresis or" has been deleted.

In claim 16, line 3, "ristomycin," has been deleted. In lines 6 and 7, "teichomycin avoparcin, actaplanins, vancomycin" have been deleted.

Claim 10 and 21-29 have been cancelled.

Authorization for this examiner's amendment was given in a telephone interview with Donald C. Lucas on September 3, 1998.

In preliminary amendment A of May 5, 1997, "This is a....September 29, 1995" has been deleted.

In preliminary amendment B of May 5, 1997, "which has been allowed....and will issue as " has been changed to - - , now - -.

The following is an examiner's statement of reasons for allowance: DePedro is considered to be the closest prior art. The case has been allowed for the reasons listed on pages 9-12 of applicant's remarks of May 5, 1997.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (703) 308-0362.

Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT/11
September 3, 1998

REMARKS

Two election of species had been required by the Examiner, one to the separation process and the other to the type of macrocyclic antibiotic. Applicant has elected conventional supported chromatography as the separation process and teichomycin (also known as teicoplanin) as the macrocyclic antibiotic. Both of these elections have been traversed.

Additionally, claim 28 has been amended to change its dependency from claim 23 to claim 27. This change is deemed to correct an obvious clerical error. It is an obvious error because claim 28 refers to ansamacrolides and glycopeptides; claim 23 (and independent claim 22 which claim 23 is dependent upon) does not refer to ansamacrolides or glycopeptides; claim 27 refers to ansamacrolides and glycopeptides, and claim 28 follows claim 27 in numerical order. Hence, claim 28 should have been dependent upon claim 27 not 23.

The first page of the Office Action identifies claim 7 as under prosecution. Pursuant to an Article 19 Amendment, claim 7 was deleted. The claims under prosecution in this case are: 1, 5, 6, 9, 10, and 15-29.

This election has been made with traverse because the instant application is based on an International Application and, under MPEP 801 and 1893.03(d), the U.S. counterpart of an International Application cannot be subject to a Restriction/Election. Such an application may only be subject to a unity of invention

requirement, 37 CFR 1.475, MPEP 1893.03(d). Since no unity of invention objection was made in the International Application, it is respectfully submitted that no objection should be made to this application.

Respectfully submitted,

BIERMAN, MUSERLIAN AND LUCAS

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By Donald Lucas
Donald C. Lucas
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